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09/742,654	12/21/2000	Michael Hannington	AVERP2850US	7505

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Heidi A. Boehlefeld
Renner, Otto, Boisselle & Sklar, L.L.P.
19th Floor
1621 Euclid Avenue
Cleveland, OH 44115

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/742,654

Applicant(s)

HANNINGTON, MICHAEL

Examiner

Victor S Chang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-29 and 32-52.Claim(s) withdrawn from consideration: 53-95.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700



NOTE

1. With respect to Applicant's argument that the adhesive of claim 1 is not claimed as a pressure sensitive adhesive, nor is it claimed as "not fully cured" and it appears that the Examiner has read those limitations into claim 1 without any support (Response, page 2, bottom paragraph), the Examiner has the following observations. First, while claim 1 does not expressly claim "pressure sensitive adhesive", claim 1 does claim an adhesive article, and Applicant clearly stated in the Specification [0004] that the instant invention is directed to solve "a need exists to make products using pressure sensitive adhesives which are repositionable"; further, in the Specification [0052], Applicant's disclosure of "upon removal of the release liner 34 and application of the exposed adhesive to the surface of substrate 37 using pressure the channels 35 collapse or partially collapse, forming voids 36 at the interface between the adhesive 32 and the substrate 37, ..." also inherently indicates that the adhesive is a pressure sensitive type, because a release liner is typically used for pressure sensitive adhesive (other types of adhesives, such as a heat activated adhesive, generally does not require a release liner). Second, the Examiner notes that an adhesive is inherently "not fully cured", because a fully cured (i.e., crosslinked) material lacks mobility and is incapable of the formation of an adhesive bond. Note also as evidence the teaching of Wu (Polymer Interface and Adhesion, S. Wu, p. 359), which teaches that "the first step in the formation of an adhesive bond is the establishment of interfacial molecular contact by wetting. The molecules will then undergo motions toward preferred configurations to

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achieve the adsorptive equilibrium, ...", Applicant's argument to the contrary notwithstanding. Finally, the Examiner reiterates that (section 4 of Paper No. 13) that it seems unlikely that a recessed route, lined with non-adhesive material, would collapse, while pulling the adhesive away from the substrate to form air egress routes at the interface between adhesive layer and substrate, because it appears that a large enough adhesion force between the facestock 31 and the non-adhesive material is required to overcome the adhesion strength between adhesive layer 32 and substrate 37. The Examiner further believes that sufficient reasoning has been provided in the rejection of claims 1-26 based on 35 USC 112, first paragraph (see section 6 of Paper No. 8 and section 4 of Paper No. 13), and the Examiner repeats that a Declaration might assist in the clarification of these issues.

2. With respect to Applicant's argument that "the Examiner has mischaracterized the adhesive article of claim 27-29 and 32-52... claim 27 is not limited to pressure sensitive adhesives" (Response, page 3, bottom paragraph), the Examiner notes that in fact that all the polymeric adhesives are not fully cured as set forth above, and consequently they are all viscoelastic materials. It should be noted that while some adhesive may be subjected to curing, or crosslinking, after adhering to the substrate to form permanent adhesive bond, however, prior to the final curing all the adhesives are not fully cured.

3. With respect to Applicant's Response arguing that "it would be apparent to those skilled in the art that the size of the non-adhesive materials forms needed and the depth to which are embedded may exceed the depth and size of the resulting channels

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created" (Response, pages 3-4, bridging paragraph), the Examiner notes that Applicant has not pointed out any express or inherent support in the specification, nor does the Examiner find such embedding process being inherently supported by the reference Rusincovitch. As such, the Examiner reiterates that "it appears that claims 27-29 and 32-52, which require greater than 100% of the thickness of the non-adhesive material to be embedded and which as such would clearly be unexpected results, are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (see section 9 of Paper No. 10).